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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,297	09/26/2003	Ken R. Powell	104.005-04	6455

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JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA, VA 22314

EXAMINER

SALIARD, SHANNON S

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,297	POWELL, KEN R.	
	Examiner	Art Unit	
	Shannon S. Saliard	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1-7. No claims have been cancelled or added. Thus, claims 1-7 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 12 October 2006 have been fully considered but they are not persuasive.
3. In response to applicant's argument that "there seems to be no way to read claim 1 onto any reasonable modification of Nemirofsky", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Specifically, Nemirofsky et al discloses, "For example, instead of receiving light from a television display, the smart card may be optically coupled to a computer screen for receiving data over a computer network" [col 8, lines 20-24]. Thus, Nemirofsky et al suggests modifying the television display with that of a computer screen.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky et al [U.S. Patent No. 6,505,773] in view of Valencia et al [U.S. Patent 5,380,991].

As per **claim 1**, Nemirofsky et al discloses a method of downloading a coupon for a product onto a smart card held by a user having access to a user computer that is in communication with a global computer network and a smart card reader/writer, the method comprising the steps of: (a) transmitting to the user, via a network, data referring to the product [col 5, lines 60-65]; (b) subsequently receiving from the user, via a network, data indicating that the user desires to receive a coupon for the product [col 3, lines 15- 19]; (c) responsive to the receiving step, transmitting to the user computer, via the global computer network, coupon data representative of the coupon [col 5, lines 63-67]; and (d) writing the coupon data, transmitted in step (c) onto the smart card with the smart card reader/writer [col 4, lines 2-16]. Moreover, Nemirofsky et al does not explicitly disclose that the information is transmitted to a user computer, via a global network. However, Nemirofsky et al discloses that the system can utilize a computer and a computer network for transmission of the coupon and coupon data [col 8, lines 20-24]. Moreover, Valencia et al discloses a paperless coupon redemption system and

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method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the method disclosed by Valencia et al. Nemirofsky et al provides the motivation that the invention achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

6. **Claims 2-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky et al [U.S. Patent No. 6,505,773] in view of Christensen et al [U.S. Patent 5,710,886] and Valencia et al [U.S. Patent 5,380,991].

As per **claims 2-4**, Nemirofsky et al discloses a method of downloading a coupon for a product onto a smart card held by a user having access to a user computer that is in communication with a global computer network and a first smart card reader/writer the method comprising the steps of: (a) transmitting to the user, via a network, data referring to the product [col 5, lines 60-65]; (b) subsequently receiving from the user, via a network, data indicating that the user desires to receive a coupon for the product [col 3, lines 15-19]; (c) responsive to the receiving step, transmitting to the user computer, via the global computer network, coupon data representative of the coupon [col 5, lines 63-67]; and (d) writing the coupon data, transmitted in step (c), onto the smart card with the first smart card reader/writer [col 4, lines 2-16]. Nemirofsky et al does not explicitly disclose that the information is transmitted to a user computer, via a global network.

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However, Nemirofsky et al discloses that the system can utilize a computer and a computer network for transmission of the coupon and coupon data [col 8, lines 20-24]. Nemirofsky et al does not disclose (e) reading the coupon data with the second smart card reader/writer; (f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data; and (g) if the list of products includes data corresponding to the coupon data, then (i) crediting the user with an amount indicated by the coupon data; and (ii) reporting the coupon to a coupon clearinghouse via a telecommunications link. However, Christensen et al discloses transmitting to coupon data to a user computer, via a global computer network [col 8, lines 42-col 9, lines 8; see fig, 10-13]; reading the coupon data; determining if a list of products includes data corresponding to the coupon data; and reporting the coupon information to a clearinghouse [col 15, lines 20-col 16, lines 26]. Moreover, Valencia et al discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see Fig. 5). Also, the Examiner takes Official Notice that it is old and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the methods disclosed by Christensen et al and Valencia et al. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet,

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organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearinghouse [col 2, lines 51-58].

7. **Claims 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen et al [U.S. Patent 5,710,886] in view of Nemirofsky et al [U.S. Patent No. 6,505,773] and Valencia et al [U.S. Patent 5,380,991].

As per **claim 5**, Christensen et al discloses a method of receiving and redeeming coupons, redeemable at a store, with a smart card with a computer in communication with a global computer network and a smart card reader/writer and having a monitor, comprising the steps of: (a) viewing a plurality of available downloadable coupons received via the computer network on the computer monitor (Fig. 10-13); and (b) subsequently generating an input to the computer indicating a selection of a selected coupon from the plurality of available downloadable coupons (see Fig. 14 and the descriptions thereof). Christensen et al does not disclose (c) receiving, data corresponding to the selected coupon, the received data having been transmitted through the global network after step (b), and causing the received data to be written to the smart card; and (d) presenting the smart card to a smart card reader/writer at the store while purchasing a product corresponding to the coupon, (e) whereby the store applies a credit specified by the coupon data to a purchase price of the product. However, Nemirofsky et al discloses a paperless coupon system and method in which a data corresponding to a coupon is viewed and subsequently the data to a selected coupon is received and written to a smart card [col 5, lines 60-65]. Moreover, Valencia

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et al discloses a paperless coupon redemption system and method in which a smart card is presented to a reader/writer while purchasing a at the store [col 9, lines 40-53]. Also, the Examiner takes Official Notice that it is and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the disclosed by Christensen et al and Valencia et al. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house [col 2, lines 51-58].

As per **claim 7**, Christensen et al discloses a system comprising: an electronic coupon downloading apparatus including: (a) a processor in communication with a computer network [Fig. 2]; and a checkout station, for reading the coupon data stored on the smart card held by a user, including: (a) a cash register; (b) a processor in communication with the cash register and with a telecommunications link [see Fig. 2]; (d) a program that executes the steps of: (i) reading coupon data; (ii) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data; and (iv) reporting the coupon to a coupon clearinghouse via the telecommunications link [col 15, lines 20-col 16, lines 26]. Christensen et al does not disclose a program that receives a user selection, sends the received selection through the computer network, receives coupon data corresponding to the selection, the

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received coupon data having been transmitted through the global computer network after the program sends the corresponding selection through the global computer network; and causes the processor to write coupon data that is received via the computer network onto a smart card via the first smart card reader/writer and a second smart card reader/writer in communication with the processor; and if the list of products includes data corresponding to the coupon data, then crediting the user with a refund of an amount indicated by the coupon data [col 4, lines 28-44]. However, Nemirofsky et al discloses a paperless coupon system and in which a data corresponding to a coupon is selected by a user and subsequently the data corresponding to a selected coupon is received and written to a smart card [col 5, lines 60-65]. Moreover, Valencia et al discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader/writer (see Fig. 5). Also, the Examiner takes Official Notice that it is old and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the methods disclosed by Christensen et al and Valencia et al. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house [col 2, lines 51-58].

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8. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Valencia et al [U.S. Patent 5,380,991] in view of Nemirofsky et al [U.S. Patent No. 6,505,773].

As per **claim 6**, Valencia et al discloses an electronic coupon downloading apparatus, comprising: (a) a processor in communication with a computer network [see col.4 lines 14-15, the host computer or computer system being coupled to the smart card: col 8, lines 15-19]; (b) a smart card reader/writer circuit, in communication with the processor, capable of writing data to a smart card [see col. 4, lines 4-26; col 6, lines 29-30 for using reader/writer]; and (c) a program that receives a user selection, and causes the processor to write data that is received via the global computer network onto a smart card via the smart card reader/writer circuit [col. 4, lines 30-36]. Valencia et al does not teach that a program receives coupon data having been transmitted through the global computer network after the program sends the corresponding selection through the global network. However, Nemirofsky et al discloses a paperless coupon system and method in which a data corresponding to a coupon is selected by a user and subsequently the data corresponding to a selected coupon is received and written to a smart card [col 5, lines 60-65]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Valencia et al to include the method of disclosed by Nemirofsky et al. Nemirofsky et al provides the motivation that the invention achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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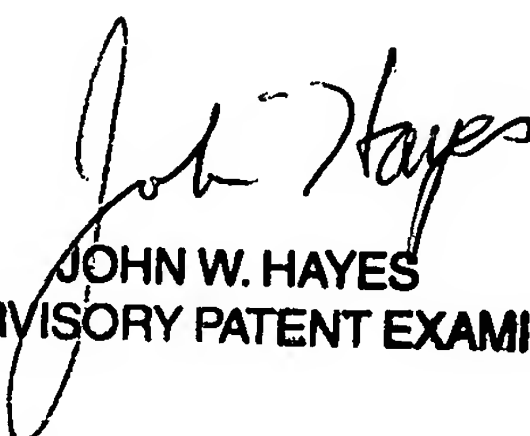
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Shannon S Saliard
Examiner
Art Unit 3628

SSS


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER